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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,442	04/20/2004	Robert J. Weisz	006593-2035	4007
33375	7590	07/29/2005	EXAMINER	
THOMPSON HINE LLP 2000 COURTHOUSE PLAZA N.E. 10 WEST SECOND STREET DAYTON, OH 45402-1758			LE, THIEN MINH	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 07/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/828,442	Applicant(s) WEISZ ET AL.	
	Examiner Thien M. Le	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The information disclosure statement and the preliminary amendment both filed on 4/20/2004 have been entered. Claims 1-27 are presented for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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Claims 1-4 and 8-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoshida et al. (Yoshida et al. – 2004/0045953; herein after referred to as Yoshida).

Regarding claims 1 and 8, Yoshida discloses a label printer unit 30 having a housing having a label exit (see figure 1) comprising a thermal head 32 having a plurality of heat generating elements 31; heat-sensitive self-adhesive label 60; an adhesive activating unit 50 comprising a thermally activating thermal head 52; platen roller 33, a label stock path and a label stock supply location (see figure 1); and a CPU (see figure 2). Also see the descriptions of figures 1 and 2 of Yoshida in the specification.

As can be seen, Yoshida discloses the claimed invention.

Regarding claim 2, see the descriptions regarding the thermal activation unit 50 as shown in figure 1.

Regarding claim 3, see figure 1 of Yoshida. The examiner considers the stock as shown in figure 1 to have the given portion and the particular portion of the stock to be side by side at the cutter unit 40.

Regarding claim 4, see the discussions regarding claim 3.

Regarding claims 9-10, see figure 1 for the arrangement of the given portion with respect to the particular portion of the stock at the cutter 40.

Regarding claim 11, see the discussions regarding claim 3.

Regarding claim 12, Yoshida discloses in the background of the invention of the use of the label stock having preformed separation liners. The examiner is of the view

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that using a label stock of having both preformed separation liners and adhesive would be a possible application of Yoshida's printing system.

Regarding claims 13-17, see the discussions of claims 9-11. Further, the functions of the cutter 40 as shown in figure 1; and the controller (the CPU) as shown in figure 2 would embrace all limitations set forth in these claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 5-7 and 18-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida et al. (Yoshida et al. – 2004/0045953; herein after referred to as Yoshida) in view of Mori (Mori – 4,932,485).

Regarding claim 7, see the discussions regarding claim 1.

The claim differs in calling for the use of the label printing apparatus together with a scale.

However, this claimed limitation is not new. Reference to Mori is cited as evidence showing the conventionality of the use of the label printing apparatus coupled to a scale at retail stores. Specifically, Mori discloses a scale 1 integrally provided with a thermal printer 8.

It would have been obvious to use the label printer as taught by Yoshida with a scale. The modification merely extends the application of Yoshida's printer to retail environments wherein both the scale and the label printer are needed.

Regarding claims 5-6, see the discussions regarding claims 1 and 7. Further, Mori is disclosing the use of the thermal printer for printing rebate, coupons which served as the claimed promotion portion of the stock. The remaining portion of the stock is considered as the given portion of the stock. As to the claimed cutter for separating the giving and the particular portions of the stock, see cutter 40 as shown in figure 1 of Yoshida.

Regarding claim 18, see the discussions regarding claims 8 and 7 above.

Regarding claims 19, 22 and 25-26, see the discussions regarding claims 1 and 8 above. Further, Mori discloses the use of the thermal printer for printing rebate information, discount coupons, etc., that would embrace all limitations set forth in this claim. (see the summary of invention of Mori).

Regarding claims 20 and 23, see the discussions of claims 7 and 18.

Regarding claim 21, see the discussions of claims 1, 7, and 19.

Regarding claim 24, see the thermal activation unit 50 of Yoshida as shown in figure 1 and its detail descriptions.

Regarding claim 27, see the discussions regarding claim 12.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (571) 272-2396. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Le, Thien Minh
Primary Examiner
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July 25, 2005